

## **REMARKS / DISCUSSION OF ISSUES**

Claims 1-7 and 21 are under present consideration. Claim 1 is independent and claim 21 is new.

Unless indicated to the contrary, amendments to the claims are provided to remove European-style phraseology. No new matter is added.

### **Objection to the Drawings**

The Office Action objects to the drawings for allegedly failing to show a leaf-type spring as featured in claim 3. Applicants respectfully disagree and direct the Examiner's attention to the leaf-type spring 37 in Figs. 6 and 7.

### **Objection to the Specification**

Applicants thank the Examiner for providing information about recommended section headings. However, Applicants respectfully decline to add the headings. Section headings are not statutorily required for filing a non-provisional patent application under 35 USC § 111(a), but per 37 CFR § 1.51(d) are only guidelines that are suggested for applicant's use. (See "Miscellaneous Changes in Patent Practice, Response to comments 17 and 18" (Official Gazette, August 13, 1996) [Docket No: 950620162-6014-02] RIN 0651-AA75 ("Section 1.77 is permissive rather than mandatory. ... [T]he Office will not require any application to comply with the format set forth in 1.77")). (See also MPEP § 608.01(a)).

### **Objections to the Claims**

The objection to the term 'curve' in claim 3 has been considered. Applicants respectfully disagree that the term is not correct. Notably, the term

modifies the leaf-type or rod-type spring (see the spring 37 in Fig. 6, for example), which is curved in an embodiment. Therefore, this term is correct and the objection is misplaced.

### **Rejections under 35 U.S.C. § 102**

1. Claims 1,2,5 and 6 were rejected under 35 U.S.C. § 102(b) as being anticipated by *Severson* (U.S. Patent 1,506,139). For at least the reasons set forth herein, Applicants respectfully submit that this rejection is improper and should be withdrawn.
2. Claims 1-3 and 5-6 were rejected under 35 U.S.C. § 102(b) as being anticipated by *Zucker* (U.S. Patent 3,302,286). For at least the reasons set forth herein, Applicants respectfully submit that this rejection is improper and should be withdrawn.

At the outset Applicants rely at least on the following standards with regard to proper rejections under 35 U.S.C. § 102. Notably, a proper rejection of a claim under 35 U.S.C. § 102 requires that a single prior art reference disclose each element of the claim. *See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983). Anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. *See, e.g., In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994); *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). Alternatively, anticipation requires that each and every element of the claimed invention be embodied in a single prior art device or practice. *See, e.g., Minnesota Min. & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992). For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person

of ordinary skill in the field of the invention. *See, e.g., Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991).

*i. Rejection in view of Severson*

Claim 1 is drawn to a hair-cutting apparatus and features:

“...[a] *movable portion being arranged and positioned to cooperate with the hair to be cut dependent on the **nature and condition** of the hair.*”

In an embodiment, when the movable/adjustable portion 35 of the passage wall 22 is cooperating with hair to be cut, the adjustable portion 35 is adjustable in opposition to the force exerted by the spring means 37, i.e. in the direction of suction 31, as indicated in FIG. 7. The amount by which the adjustable portion 35 is adjusted is dependent in this case on the nature and condition of the hair, i.e. **on the density of the hair, the length of the hair, the thickness of the hair and the stiffness of the hair.**

The Office Action asserts:

that is movable relative to the stationary portion. Severson also teaches that the movable portion is being arranged and positioned to cooperate with the hair to be cut dependent on the nature and condition of the hair. It should be noted that the movable portion 37 moves back on its pivot against the action of spring 41 when the movable portion is pushed against the hair. Therefore, the movement of the movable portion is according to the nature and condition of the hair. See Figs. 1-3 and page 2, lines 6-115 in Severson.

At the outset, the undersigned believes that the reference characters noted above do not properly refer to the applied art, but rather to an amalgamation of the reference characters of the applied art and the features of claim 1. For instance,

‘37’ refers to a hood or shield in the reference; and ‘41’ refers to the medial coil of the spring 41. Regardless, the hood or cover 37 is used to regulate suction.

Moreover, while the reference discloses the pivoting of the instrument at portion 11 to regulate the length of the hair, there is no disclosure of the *movable portion’s being arranged and positioned to cooperate with the hair to be cut dependent on the **nature and condition** of the hair*. To wit, only the length of the hair is of concern; and the regulation of the length is by a pivot point at portion 11, which is not even a moveable portion, let alone one arranged and positioned to cooperate with the hair to be cut dependent on the nature and condition of the hair. Stated differently, the hood or cover 37 and its spring actuation 40 are provided to regulate suction, and are not arranged to cooperate with the hair to be cut dependent on the nature and condition of the hair as claimed. Moreover, the reference does not disclose the adjustability of the hair-cutting apparatus dependent on the nature and condition of the hair as claimed.

***ii. Rejection in view of Zucker***

The Office Action asserts that the comb plate 59 of *Zucker* anticipates the *movable portion’s being arranged and positioned to cooperate with the hair to be cut dependent on the **nature and condition** of the hair* as featured in claim 1. Applicants respectfully disagree.

The comb plate 59 is floatingly mounted to the main frame 12 by wings or extensions 62. The comb plate 59 includes teeth 60 and lifts hair and aligns it and brings it into cutting position in juxtaposition with the clippers 24a. However, the reference fails to disclose the arrangement of a movable portion *being arranged and positioned to cooperate with the hair to be cut dependent on the **nature and condition***. Rather, there is merely a description of aligning the hair to be cut; and conspicuously there is neither mention of nature or condition of the hair being cut

nor of the adaptability of the position and arrangement of any components dependent thereon.

***iii. Rejections are improper***

For at least the reasons set forth above, Applicants respectfully submit that the applied art fails to disclose at least one feature of independent claim 1. Thus, a *prima facie* case of anticipation has not been made and claim 1 is patentable over the applied art. Moreover, claims 2-7 and 21, which depend from claim 1 are patentable for at least the same reasons.

**Rejections under 35 U.S.C. § 103**

The rejection of claims 3 and 4 under this section of the Code have been considered. As these claims depend from claim 1, which is patentable over the applied art, claims 3 and 4 are patentable for at least the same reasons.

**New Claim**

Claim 21 is added to clearly distinguish the hair-cutting apparatus from the applied art, at least by the feature of suction means contained in the apparatus. By contrast, the suction means of the applied art is not contained in the instrument, but rather connected to the instrument.

**Conclusion**

In view the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance.

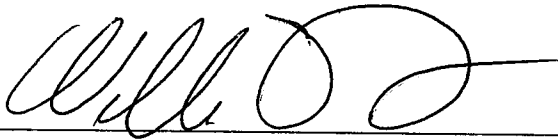
If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies to charge payment or credit any overpayment to Deposit Account

Number 50-0238 for any additional fees, including, but not limited to, the fees under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17.

If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted on behalf of:

Phillips Electronics North America Corp.

A handwritten signature in black ink, appearing to read 'William S. Francos', written over a horizontal line.

by: William S. Francos (Reg. No. 38,456)

Date: May 21, 2007

Valentine Francos & Whitt, PLLC  
Two Meridian Blvd.  
Wyomissing, PA 19610  
(610) 375-3513 (v)  
(610) 375-3277 (f)